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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,884	03/15/2001	Naohiro Furukawa	ASAM.0007	3520
38327	7590	11/03/2005	EXAMINER	
REED SMITH LLP 3110 FAIRVIEW PARK DRIVE, SUITE 1400 FALLS CHURCH, VA 22042			NGUYEN BA, PAUL H	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/805,884	FURUKAWA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Paul Nguyen-Ba	2176	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 August 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/10/2005 has been entered.
2. Claims 1-17 are currently pending. Claims 1, 2, 6, 7, 10, 13, and 14 are independent claims.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruce et al. ("Bruce"), U.S. Patent No. 6,741,724, in view of Stinson et al. ("Stinson"), U.S. Patent No. 6,695,204.

### Independent Claim 1

Bruce teaches a form processing system comprising:

*a management system...for creating and managing a form identification dictionary for identifying a type of printed form (see col. 3 lines 41-45 and col. 10 lines 1-12 → "printed" form) (also see col. 4, lines 32-50; col. 5, lines 10-14 → Video Coding Computer (VCC) performs a check to in a verification database (compare with "form identification dictionary")) to identify whether the text is valid and then formats, buffers, and ultimately stores the newly updated or created data in the National Change of Address (NCOA) database); and*

*a plurality of form processing terminals...to process the form (see Fig. 2; col. 2, lines 44-50; col. 4, lines 15-41 → the processing terminals scans the forms, processes the images, and analyzes the text data (i.e. Scanner, OCR, Arbitrator)); wherein*

*said management system...and said plurality of...terminals are interconnected via network (see Figs. 1-4; col. 3, lines 61-65 → terminals (Scanner, OCR, Arbitrator) are linked together with the management system (VCC, Verification database, NCOA database, and VDT) in a network);*

*said form processing terminal, upon occurrence of failure...transmits image information of the form to said management system of form identification dictionary (col. 2, lines 49-56; col. 4, lines 32-34 → the text data in the form of an electronic data stream is sent to a VCC along*

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with a copy of the image data from scanner and Arbitrator if the scanning error probability exceeds a predetermined limit); and

*said management system...when said image information...has not been registered* (i.e.

Change of Address (COA) request had not previously been registered in the NCOA

database)...*creates information for identifying the type of form..., stores...*(col. 2, lines 61-64;

col. 3, lines 19-21; col. 5, lines 10-14 → VCC updates and stores newly created or revised information in the NCOA database).

Bruce does not specifically teach transmitting *the created information to said form processing terminal*.

However, Stinson teaches a check reader and processor (i.e. processing terminal) configured to receive information about the check to be processed from the check reader, access the database (i.e. management system) to obtain information, and determine whether to accept or reject the check based on input signals for the purpose of automatic check form identification (see Abstract).

Since Stinson and Bruce are both from the same field of endeavor, the purposes disclosed by Stinson would have been recognized in the pertinent art of Bruce. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Bruce with the teachings of Stinson to include transmitting *the created information to said form processing terminal* by input signals for the purpose of automatic form identification and database updating.

### **Independent Claim 2**

With respect to independent claim 2, refer to the rationale relied upon to reject independent claim 1. However, Bruce does not specifically teach the system wherein *when said image information...has been registered...reads out information for identifying the type of form...and transmits the read-out information to said form processing terminal.*

However, if the Change of Address information had already been registered in the NCOA database, it was commonly known to those of ordinary skill in the art that the management system (VCC, NCOA database, etc.) would read out the information and transmit the information to the form processing terminals for the purpose of informing the customer that his information was already updated or created and that no further processing is necessary.

### **Claim 3**

Bruce further teaches a form processing system wherein *said form processing terminal, upon occurrence of failure...transmits to said management system...the image information of the form together with information for supporting a work of creating the form identification dictionary* (col. 2, lines 49-56; col. 4, lines 32-34 → the text data in the form of an electronic data stream is sent to a VCC along with a copy of the image data from scanner and Arbitrator if the scanning error probability exceeds a predetermined limit).



**Claim 4**

Bruce teaches a form processing system with respect to independent claim 1 discussed above, but does not specifically teach *when said form identification dictionary...is updated, informs said plurality of form processing terminals of form...update information; and said management system..., upon reception of a request for use..., distributes the form identification information as requested to...terminals.*

However, Stinson teaches a check reader and processor (i.e. processing terminal) configured to receive information about the check to be processed from the check reader, access the database (i.e. management system) to obtain information, and determine whether to accept or reject the check based on input signals specifying updated information from the database for the purpose of automatic form identification (see Abstract).

Since Stinson and Bruce are both from the same field of endeavor, the purposes disclosed by Stinson would have been recognized in the pertinent art of Bruce. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Bruce with the teachings of Stinson to include *informing said plurality of form processing terminals of form...update information; and said management system..., upon reception of a request for use..., distributes the form identification information as requested to...terminals* for the purpose of automatic form identification and database updates.

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### **Claim 5**

Bruce teaches a form processing system with respect to claim 4 discussed above, but does not specifically teach *said management system...comprises a manager of system fee; and said manager of system fee...performs charging to said form processing terminals.*

However, Stinson teaches a processor for determining a fee to charge customer for the purpose of seeking monetary retribution for services rendered (see col. 13, lines 11-15).

Since Stinson and Bruce are both from the same field of endeavor, the purposes disclosed by Stinson would have been recognized in the pertinent art of Bruce. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Bruce with the teachings of Stinson to include *management system...comprises a manager of system fee; and said manager of system fee...performs charging to said form processing terminals* for the purpose of seeking monetary retribution for services rendered.

### **Independent Claim 6**

Management system claim incorporates substantially similar subject matter as independent claim 1, and is rejected along the same rationale.

### **Independent Claim 7**

Management system claim incorporates substantially similar subject matter as independent claim 2, and is rejected along the same rationale.



**Claim 8**

Management system claim incorporates substantially similar subject matter as claim 4, and is rejected along the same rationale.

**Claim 9**

Management system claim incorporates substantially similar subject matter as claim 5, and is rejected along the same rationale.

**Independent Claim 10**

Form processing terminal claim incorporates substantially similar subject matter as independent claim 1, and is rejected along the same rationale.

**Claim 11**

Form processing terminal claim incorporates substantially similar subject matter as claim 3, and is rejected along the same rationale.

**Claim 12**

Form processing terminal claim incorporates substantially similar subject matter as claim 4, and is rejected along the same rationale.

**Independent Claim 13**

Method of distributing form identification information claim incorporates substantially similar subject matter as independent claim 1, and is rejected along the same rationale.

**Independent Claim 14**

Method of distributing form identification information claim incorporates substantially similar subject matter as independent claim 2, and is rejected along the same rationale.

**Claim 15**

Method of distributing form identification information claim incorporates substantially similar subject matter as claim 3, and is rejected along the same rationale.

**Claim 16**

Method of distributing form identification information claim incorporates substantially similar subject matter as claim 4, and is rejected along the same rationale.

**Claim 17**

Method of distributing form identification information claim incorporates substantially similar subject matter as claim 5, and is rejected along the same rationale.

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*Response to Arguments*

6. Applicant's outstanding arguments filed 8/10/2005 have been fully considered but they are not persuasive.

Applicant contends that the cited prior art, Bruce, fails to teach or suggest a "printed" form. Applicant bases this contention on two premises: 1) the data elements updated in Bruce are hand-written, rather than printed, and 2) that Bruce's "OCR software ignores the preprinted data on the form" (col. 4, line 27), thus teaching away from the instant invention. Examiner respectfully disagrees.

Applicant's arguments zero in on only one of the two embodiments taught by Bruce. Examiner directs Applicant's attention to col. 10, lines 1-14 of the Bruce reference. Bruce teaches the alternate embodiment wherein the "forms will be printed rather than handwritten and thus will be much easier to scan."

As to the specific question of "teaching away," in *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir.1994) stated:

A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

Clearly a skilled artisan is *encouraged* and taught by Bruce, at col. 10, lines 1-14, to use "printed" forms for ease in scanning. Moreover, the fact that Bruce teaches the option of ignoring the pre-printed data on the form does not necessitate ignoring the relevant "printed" data on said forms.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-4094. The examiner can normally be reached on 11 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PNB

*William L. Bashore*  
WILLIAM BASHORE  
PRIMARY EXAMINER  
10/31/2005